

Remarks

Claims 5 through 8 stand rejected under 35 USC 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention referring to "the tube filling machine and/or for removing tubes" in the preamble of claim 5. In response thereto, the "and/or" recitation has been replaced with "or". Review and acceptance is requested.

Claims 5 through 8 stand rejected under 35 USC 103(a) as being unpatentable over Linner '224 in view of Kress '631.

In response to these rejections, the Applicant has amended independent claim 5 to incorporate the limitations of former claim 7 which has accordingly been cancelled. Former claim 7 was rejected by the Examiner in view of the following remarks made on page 3 second paragraph of the Office Action:

"Re claims 7 and 8, it would have been obvious to those skilled in the art to optimize the spacing between the grippers and the application of the cylinders to provide an adjustment to a user"

The Applicant respectfully disagrees with this rejection for the following reasons.

Making a device adjustable is only obvious when prior art acknowledges a recognized need for effecting adjustment. Absent motivation for a need to adjust, making adjustable is not necessarily obvious (In re Stevens, 212

F.2d 197, 101 USPQ 284 (CCPA 1954)). With regard to the instant invention, none of the prior art of record proposes or suggests the need for an adjustable position at which the pneumatic cylinders address the scissors mechanism. Moreover, most importantly, former claim 7 did not claim adjustability per se rather specified a specific region of the scissors at which the pneumatic cylinders should engage. Therefore, adjustability is neither suggested by the prior art nor claimed in former claim 7. For this reason, the grounds of rejection given by the USPTO argumentation was in error.

Furthermore, detailed examination of the prior art of record shows that, taken alone or together, the prior art references actually teach away from the limitations of claim 5 as amended.

Linner '224 proposes a tube adjusted mechanism having two oppositely driven pneumatic cylinders engaging the ends of a row of tubes. The row of tubes is held together by a belt which can be stretched in response to being driven by the cylinders. Since the belt must be tensioned for accurate positioning of the tubes, the cylinders must engage the outer members at of the row, at left and right ends thereof, in order to ensure that all tubes remain captured in the tightened belt. Therefore, Linner provides no motivation for positioning the engagement points of the pneumatic cylinders at any location other than the end tube positions of the series of tubes (see Linner column 4, lines 8 through 20 and figure 4).

Kress '631 proposes a scissor mechanism for changing separations between a row of elements. The mechanism with which the scissors is moved involves a central bearing point 7 and 19 which moves vertically in

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a slot of a fixed plate 49. The scissors mechanism is engaged at end points thereof 5 and 6 and is driven apart and together by means of a belt 4 which engages the front side of one end of the scissors 6 and the rear side of the other end of the scissors 5. As one end is thereby pulled to the right, the other end is pushed to the left and vice versa thereby causing the scissors to be expanded and retracted. The fixed positioning of the bearing mechanism 7 and 19 in the slot allows for vertical motion of that bearing mechanism as the scissors are opened or closed without shifting the position of that bearing mechanism in the horizontal direction. Kress states that this particular situation is advantages, since it results in a precise and reproducible positioning mechanism (see in particular Kress column 6 lines 42 through 57 as well as column 7 lines 19 through 49).

One of average skill in the art, aware of the disclosures of Kress and Linner, would not be motivated to reposition the point of engagement between the pneumatic cylinders and the scissor mechanism to assume values which are approximately one quarter of a length thereof, since both Linner and Kress teach engagement at the ends of the scissor mechanism and since engagement in another positions would destroy the function of Linner as discussed above and is deemed not advantageous in view of the Kress disclosure. Therefore, the prior art of record not only fails to provide motivation for the limitations of amended claim 5 but actually teaches away from the limitations by stating that intermediate positioning is disadvantageous.

The invention as amended recites specific structural features which have turned out to improve performance of the motion mechanism while effecting a advantageous compromise between the size and the pneumatic

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cylinders and the extent or magnitude of the adjustment force required to effect motion of the tubes, taking into consideration the introduction of those forces into the scissor mechanism. None of the prior art provides motivation for this limitation therefore rendering amended claim 5 sufficiently distinguished from the prior art to satisfy the conditions for patenting in the United States. The Applicant therefore requests passage to issuance.

No new matter has been added in this amendment.

Respectfully submitted,

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